



Action n°: UPC CFI 316 /2023

Revocation action 571808/2023

DECISION

of the Court of First Instance of the Unified Patent Court

Central division Paris Seat (Section 1)

delivered on 17 January 2025

concerning EP 3 430 921 B1

KEYWORDS: Revocation, claim interpretation, clarity, added matter, admission of auxiliary claims

CLAIMANT:

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Represented by Attorney-at-law Hon.-Prof. Dr. Henrik Holzapfel, McDermott Will & Emery, Stadttor 1, 40219 Düsseldorf, Germany

Also represented at the hearing by

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DEFENDANT:

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- Andreas Mötsch, German and European Patent Attorney, Thum & Partner
- Dr. Jonas Weickert, German and European Patent Attorney, Thum & Partner
- Dr. Tobias Wuttke, Attorney at Law, Bardehle Pagenberg
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PATENT AT ISSUE

European patent **EP 3 430 921 B1**, hereafter referred to as “EP 921” or as “the Patent”.

PANEL/DIVISION

Panel 1 of the Central Division (Paris Seat)

DECIDING JUDGES

This decision has been delivered by the presiding judge **François Thomas**, the legally qualified judge and judge-rapporteur **Maximilian Haedicke** and the technically qualified judge **Max Tilmann**.

DATE OF THE ORAL HEARING

19 November 2024

SUMMARY OF FACTS AND REQUESTS

1 The dispute

1.1 On 13 September 2023, Claimant brought a revocation action¹ against Defendant at the Paris Central Division of the Unified Patent Court (Action n°:

¹ The Statement of Revocation, Defence to Revocation, Reply to the Defence to Revocation and Rejoinder to the Reply to the Defence to Revocation are herein referred to as ‘SfR’, ‘DtR’, ‘RtD’ and ‘R’, respectively.

UPC CFI 316 /2023 Revocation action 571808/2023), requesting the Court to revoke European Patent No. EP 3 430 921 B1.

- 1.2 On 26 October 2023, Defendant filed a Preliminary objection pursuant to Rules 19.1(a) and 48 of the Rules of Procedure of the Unified Patent Court ('RoP') denying the competence of the Court on the grounds of an allegedly false denomination of Defendant by Claimant. The Court rejected the Preliminary objection. This holding was confirmed on appeal No. APL_588426/2023 UPC_CoA_438/2023.
- 1.3 A Statement of Defence to Revocation dated 4 December 2023 was filed on 20 December 2023. At the same time and within the same submission, an Application to amend the Patent was filed. A Reply to the Defence was submitted on 21 February 2024, including a Defence to an Application to amend the Patent. The Court also received a Rejoinder to the Reply, dated 21 March 2024, that included a Reply to the Defence to an Application to amend the patent. On 22 April 2024, Claimant filed a Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent in suit.
- 1.4 On 31 May 2024, the Court received a further submission by Defendant entitled "Comments to Claimant's submission of 22 April 2024 including the Reply to Defendant's rejoinder and the Reply to Defendant's application to amend the patent".
- 1.5 On 21 June 2024, the interim conference was held.
- 1.6 By order of 25 June 2024, the Court – inter alia – set out the order allowing Defendant to identify, within the set of auxiliary requests already on file, those set of claims that it wants to pursue further until 30 October 2024.
- 1.7 On 30 October 2024, Defendant identified 12 auxiliary requests to be pursued during the oral hearing.
- 1.8 On 8 November 2024, the Court received the summaries sent by the parties.
- 1.9 On 13 November 2024, Defendant submitted a subsequent request to amend the patent.
- 1.10 The oral hearing was held on 19 November 2024.
- 1.11 For the submissions of the parties and previous orders issued by the Court, reference is made to the case file in the Case Management System.

2 The patent

- 2.1 The Patent EP 3 430 921 B1 **Exhibit MWE 1** entitled VAPORIZATION DEVICE SYSTEMS was filed on 23 December 2014.
- 2.2 As indicated by Claimant in mn 6 SfR and undisputed by Defendant, the Patent EP 3 430 921 B1 **Exhibit MWE 1** (application number 18000692.6;

application documents as filed: **MWE 3**) is based on a divisional application to the European application 14873186.2, being the “regional phase” to and originally filed as International Patent Application PCT/US2014/072230 published as WO 2015/100361 A1, **Exhibit MWE 4**, also referred to as “parent application” in the following. EP 3 430 921 B1 claims priority from US Provisional Patent Applications nos. 61/920,225, (**Exhibit MWE 5**; filed on 23 December 2013), 61/936,593 (**Exhibit MWE 6**; filed on 6 February 2014) and 61/937,755 (**MWE 7**; filed on 10 February 2014).

- 2.3 The publication of the mention of the grant of the Patent was made on 4 August 2021. Registered owner of the Patent is Defendant.
- 2.4 According to Claimant’s Statement for Revocation (SfR; mn 5) and undisputed by Defendant, EP921 was valid in the following member states of the UPCA at the time of filing the SfR: Belgium, France, Germany, Italy, Luxembourg, Netherlands, Portugal and Sweden.
- 2.5 Oppositions against the grant of the Patent at the European Patent Office (“EPO”) were pending at the time of filing the SfR; Claimant is not party to the opposition proceedings.
- 2.6 Claim 1 of the Patent, as granted, reads:

A device (10) for generating an inhalable aerosol comprising:

*a device body (20) comprising a cartridge receptacle (21); and
a cartridge (30, 30a) comprising;*

*a heater (36, 105, 205, 305) comprising at least one
condensation chamber,
a fluid storage compartment (32), and
a mouthpiece (31), wherein*

*the heater is attached to a first end of the fluid storage compartment
(32),*

*the mouthpiece is attached to a second end of the fluid storage
compartment (32), and*

*the device comprises an air inlet passage (51) formed when the
cartridge is inserted into the cartridge receptacle (21), characterised
in that either:*

- a channel integral to an exterior surface of the cartridge forms a first side of the air inlet passage and an internal surface of the cartridge receptacle forms a second side of the air inlet passage, or

- a channel integral to the internal surface of the cartridge receptacle forms the first side of the air inlet passage and the exterior surface of the cartridge forms the second side of the air inlet passage.

2.7 Claim 11 of the Patent, as granted, reads:

A cartridge (30, 30a) configured to be inserted into a cartridge receptacle (21) of a device body, the cartridge comprising:

a heater (36, 105, 205, 305) comprising at least one condensation chamber,

a fluid storage compartment (32), and

a mouthpiece (31),

wherein the heater is attached to a first end of the fluid storage compartment (32),

the mouthpiece is attached to a second end of the fluid storage compartment (32), and characterized in that

the cartridge is configured to form an air inlet passage (51) when the cartridge is inserted into the cartridge receptacle (21), wherein

- a channel integral to an exterior surface of the cartridge is configured to form a first side of the air inlet passage and an internal surface of the cartridge receptacle is configured to form a second side of the air inlet passage.

3 Requests

3.1 Claimant requests:

- (1) European patent n° EP 3 430 921 be revoked with effect for the territories of Belgium, France, Germany, Italy, Luxembourg, Netherlands, Portugal and Sweden.
- (2) To dismiss Defendant's alternative requests to maintain the Patent in suit based on any of Defendant's proposed amendments of the claims of the Patent in suit, including all of Defendant's Auxiliary Requests, and Defendant's alternative requests (2)(c) and (d) (as set forth in the DfR).
- (3) to dismiss Defendant's request (3) as put forth in the RtD and, in case that the Court deems it necessary, to admit Exhibits MWE 20 to 50 to the proceedings.
- (4) Defendant be ordered to bear the legal costs of the proceedings.

3.2 Defendant requests:

- (1) the revocation action be dismissed;
- (2) the patent in suit be maintained:
 - a. as granted;
 - b. in the alternative, based on the proposed amendments of the claims of EP 921 according to the subsequent application of 13 November 2024 to amend the patent in suit (to include Auxiliary Requests IIA, VIIA, VIIIA, IXA and XIIA), wherein the Auxiliary Requests as submitted on 30 October 2024 and the Auxiliary Requests according to the present subsequent Application to amend the patent shall be discussed in the order of Auxiliary Requests I, II, IIA, III, IV, V, VI, VII, VIIA, VII, VIIIA, IX, IXA, X, XI, XII, XIIA;
 - c. in the event that the present subsequent application of 13 November 2024 to amend the patent is not admitted,

based on the Auxiliary Requests I to XII as submitted on 30 October 2024;

further in the alternative, EP 921 be maintained based on one of the motions (2) b. to (2) d. as set forth in the Statement of Defence, i.e.:

in the alternative, based on one of the proposed amendments of the claims of the patent in suit (Auxiliary Requests 1 to 65); ((2) b. as set forth in the Statement of Defence)

further in the alternative, in parts based on the independent validity of one or more of its dependent claims in combination with independent claim 1 as granted; ((2) c. as set forth in the Statement of Defence); and

yet further in the alternative, in parts based on the independent validity of one or more of its dependent claims as granted in combination with claim 1 according to one of the proposed amendments of the claims of the patent in suit ((2) d. as set forth in the Statement of Defence)

(3) documents MWE 20 to MWE 50 not be admitted into the proceedings;

(4) Claimant to bear the costs of the proceedings.

Regarding the submission of 22 April 2024, Claimant further requests to admit this submission also insofar as the submission is not limited to commenting on Defendant's Application to amend the Patent.

Regarding the submission of 31 May 2024, Defendant further requests admission of this response.

Defendant further requests admission of the submission of 13. November 2024.

4 The arguments

4.1 As far as they are relevant for the present decision, the arguments of the parties can be summarized as follows:

- 4.2 Regarding the main claim 1, Claimant states that the invention claimed therein is not valid for several reasons. Claimant argues that the following reasons for revocation apply:
- added matter (Article 138(1)(c) EPC, with reference to Articles 76(1) and 123(2) EPC),
 - lack of novelty (Article 138(1)(a) EPC, with reference to Articles 52(1) and 54 EPC, and
 - lack of inventive step (Article 138(1)(a) EPC, with reference to Articles 52(1) and 56EPC.
- 4.3 Regarding the issue of “added matter”, Claimant in particular argues that Claim 1 of the Patent contains subject matter extending beyond the disclosure of the application no. 18000692.6 Exhibit **MWE 3** as originally filed and parent application PCT/US2014/072330 Exhibit **MWE 4** in the form of at least the following limitations:
- the heater is attached to a first end of the fluid storage compartment (features 1.4 and 11.5), added to claims 1 and 11 in an amendment filed on 31 July 2019;); and
 - the mouthpiece is affixed to a second end of the fluid storage compartment (features 1.5 and 11.6), added to claims 1 and 11 in the amendment filed on 31 July 2019.
- 4.4 Claimant argues that the attachment of the heater to a first end of the fluid storage compartment (features 1.4 and 11.5) is not disclosed by, or derivable directly and unambiguously from, statements that the heater is attached to the first end of the cartridge or statements that the heater encloses a first end of the fluid storage compartment.
- 4.5 To substantiate this, Claimant first refers to the reference in MWE 3 to the attachment of the heater to the first end *of the cartridge*. Claimant considers that the attachment of the heater to a first end of the fluid storage compartment is neither disclosed by nor directly and unambiguously derivable from statements that the heater is attached to the first end of the cartridge.
- 4.6 Claimant further refers to the reference in MWE 3 to the heater enclosing a first end of the fluid storage compartment. Claimant considers that the *attachment* of the heater to a first end of the fluid storage compartment is neither disclosed by nor directly and unambiguously derivable from statements that the heater *encloses* a first end of the fluid storage compartment.

- 4.7 Claimant refers to statements regarding the attachment of the heater to a “first end”. Claimant considers it unclear whether the “first end” mentioned in these statements is the first end of the cartridge or the first end of the fluid storage compartment. Claimant states that a person skilled in the art would interpret the “first end” mentioned in the statements to be references to the first end of the cartridge, and not a first end of the fluid storage compartment. In this regard Defendant points (SfD mn 32) to [0025], [0032], [0035], [0042], [0048] and [00209] of MWE 3.
- 4.8 Claimant argues that the attachment of the mouthpiece to a second end of the fluid storage compartment is not disclosed by, or derivable directly and unambiguously from, statements that the mouthpiece is attached to the second end of the cartridge or statements that the mouthpiece encloses a second end of the fluid storage compartment.
- 4.9 Claimant considers that the *attachment* of the mouthpiece to a second end of the fluid storage compartment (features 1.5 and 11.6) is not disclosed by, or directly and unambiguously derivable from statements that the mouthpiece is attached to the second end of the cartridge or statements that the mouthpiece is *enclosing* a first end of the fluid storage compartment (SfR mn 39).
- 4.10 Claimant refers to statements regarding the attachment of the mouthpiece to a “second end”. In view of the numerous references to attachment of the mouthpiece to a second end of the cartridge, Claimant considers that a person skilled in the art would interpret “the second end” to be a reference to the second end of the cartridge, and not an end of the fluid storage compartment.
- 4.11 Defendant relies on the method described in cl. 158 and [0046] and the Fig. 9I and 9J. According to Defendant, these Fig. show the cartridge to comprise a fluid storage compartment (transparent component) to which a mouthpiece (component 31) and a heater (black component on the bottom side) are attached (mn 59). According to Defendant, the original paragraph [00179] - in relation to Fig. 9 - specifies a fluid storage compartment having the heater and the mouthpiece attached thereto (mn 60).
- 4.12 Regarding the attachment of the heater and the mouthpiece *to the first and second ends* of the fluid storage compartment, Defendant states that this is described step-by-step in [00179] with reference to Fig. 9 (mn 61). In detail, Defendant, by reference to Fig. 9A, argues that it is directly and

- unambiguously derivable for a person skilled in the art from Fig. 9A that the fluid storage compartment 32a *has* a first end and a second end.
- 4.13 Defendant argues that the Figs. 9B to 9L show how different components like the heater and the mouthpiece are attached to the first end and the second end of the fluid storage compartment (mn 63).
- 4.14 Defendant claims that original Fig. 9I clearly shows an attachment of the mouthpiece 31 to the second end of the fluid storage compartment. In Fig. 9J, the mouthpiece 31 is shown attached to the fluid storage compartment.
- 4.15 In the hearing on 19. November 2024 Defendant questioned, if the term “first end” in the wording of claim 158 of MWE 4 contained any ambiguity and set forth that from the structure of claim 158 it was clear to the skilled person that the term “affixing a heater to a first end” was to be seen as next method-step in a sequence of method-steps after the initial method-step of providing the fluid storage compartment and that from this sequence of method-steps it was clear that “a first end” was the first end of the fluid storage tank that was provided in the method-step immediately preceding the method-step of “affixing a heater to a first end”. Defendant further argued in the hearing that if there were any ambiguity in claim 158 as to the meaning of the first end, this could be overcome by looking at [0179] that showed – as first method-step – the provision of a fluid storage compartment and as next method-step the placement of the heater on the fluid storage compartment.
- 4.16 Claimant additionally points to a disclosure that states that “first heater contact plates 33 that are fixed to the sides of the first end of the tank and straddle the open-sided end 53 of the tank”. Claimant argues that it is not unambiguously clear that the “tank” and “fluid storage compartment” are synonymous. Hence, Claimant considers that nothing can be deducted from the above cited sentence (SfR mn 33, 34) concerning the original disclosure of a heater being attached to a first end of the fluid storage compartment.
- 4.17 With regard to the Amendment A2, Claimant argues that the Patent does not explain how the heater can enclose the first end of cartridge when that cartridge comprises the heater. It is also unclear how the heater can enclose the first end of the cartridge when it is affixed to the first end of the fluid storage compartment (Reply to Defence to Revocation mn 359).
- 4.18 With regard to the Amendment A4, Claimant argues that the Patent does not explain how the mouthpiece can enclose the second end of cartridge when that cartridge comprises the mouthpiece. It is also unclear how the

mouthpiece can enclose the second end of the cartridge when it is affixed to the second end of the fluid storage compartment (Reply to Defence to Revocation mn 390).

GROUNDINGS FOR THE DECISION

5 Late-filed facts and evidence

- 5.1 Defendant requests documents MWE 20 to MWE 50 not be admitted into the proceedings; Claimant requests to dismiss Defendant's request and, in case that the Court deems it necessary, to admit Exhibits MWE 20 to 50 to the proceedings.
- 5.2 Due to the front-loaded approach of the UPC system, R44 RoP requires the Statement for revocation to contain an indication of the facts relied on (R44 (f) RoP) and the evidence relied on, where available and an indication of any further evidence which will be offered in support (R44 (g) RoP). Similarly, the RoP contain provisions which define the admissible content of the further submissions. The parties are under an obligation to set out their full case as early as possible (Preamble RoP 7, last sentence) and to provide all their legal and factual arguments, and any evidence supporting it in a timely manner.
- 5.3 Whenever possible, Claimant is obliged to submit its arguments, facts and attachments in its Statement for Revocation, which it has plenty of time to prepare. However, when submitting the Statement for Revocation, Claimant cannot anticipate which points Defendant will dispute or the means by which it will do so. Therefore, in its Reply to the Statement of Defence, Claimant is allowed to present arguments in response to arguments raised by Defendant in its Statement of Defence.
- 5.4 A clear distinction between newly introduced arguments and arguments raised as a mere reaction to previously filed arguments cannot always be drawn. In order to secure fairness and equity of the proceedings (Preamble RoP 5), especially to safeguard the fundamental right to be heard, a generous standard is to be applied. An argument which may be considered a further reaching response to the other party's previously raised argument is to be admitted.

Reply to the Statement of Defence and Hajaligol Declaration

- 6 In its Reply to the Statement of Defence dated 21 February 2024, Claimant filed 25 new documents. Defendant requests not to admit any of the newly filed documents into the proceedings. This request especially pertains to the preclusion of the Hajaligol Declaration (MWE 20) and all enclosures.

- 6.1 The Hajaligol report is admissible as far as it is a reaction to arguments submitted in the Statement of Defence. Therefore, the report is admissible as far as it contains arguments regarding the common general knowledge ('State of the art before the critical filing date of the Patents', mn. 21 -33). These arguments are raised in response to arguments raised by Defendant in its Statement of Defence to Revocation mn 16 et seq. Their submission is therefore admissible.
- 6.2 The "Hajaligol Declaration" is also admissible as far as it can be considered a response to Dr. Collins proposed construction of the claim features of the patent in suit. The report takes issue with the Collins declaration and focuses on alleged contradictions. A clear distinction between newly added arguments and arguments which are used as a response to Dr. Collins' report cannot be drawn. In order to secure Claimant's right to be heard, the entire Hajaligol report is admitted into the proceedings, including its attachments.

Rejoinder to the Reply to the Defence to Revocation / Reply to the Defence to the Application to amend the patent

- 6.3 Rule 52 delineates the scope of the Rejoinder to the Reply to the Defence to Revocation. According to Rule 52, 'the defendant may lodge a Rejoinder to the Reply to the Defence to Revocation together with any Reply to the Defence to an Application to amend the patent pursuant to Rule 43.3 and 55 (..). The Rejoinder shall be limited to a response to the matters raised in the Reply.'
- 6.4 Therefore, as far as the Rejoinder to the Reply to the Defence to Revocation (21 March 2024) is concerned, the arguments regarding the admissibility of the Hajaligol Declaration are admitted. Page 1-19 of the Rejoinder are therefore admissible.
- 6.5 P. 19-35 of the Rejoinder are a response to Claimant's Reply to the Defence to Revocation and to the arguments contained in the Hajaligol Declaration. As the content of the Hajaligol Declaration is admitted, the response thereto should also be admitted. P. 19-35 are therefore admitted.
- 6.6 P. 35-96 of the Rejoinder are admitted. They focus on general issues concerning patentability, but at the same time, they constitute a response to the Hajaligol Declaration and to the Reply to the Defence to Revocation. As previously mentioned, in order to safeguard the fundamental right to be heard, a generous standard is to be applied.
- 6.7 Similarly, the expert report of Ramon Alacon (Exhibit TP-10) is admissible, as it can be considered a reaction to the Hajaligol Declaration, which is admitted to the proceedings, too.
- 6.8 According to Rule 55, 32.3 RoP, the 'proprietor may lodge a Reply to the Defence to the Application to amend the patent within one month of service

of the Defence (...)' . Applying this rule, this submission of 21 March 2024 is also admissible as far as it is commenting on the Application to amend the patent. Therefore, P. 116 et seq. are admitted.

Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent in suit

- 6.9 On 22 April 2024, Claimant filed a 'Reply to the Rejoinder and Reply to Defendant's Application to amend the Patent in suit'.
- 6.10 According to Rules 55, 43.3, 32.3 RoP, Claimant may lodge a Rejoinder regarding Defendant's Application to amend the Patent in suit. P. 15-80 deal with Defendant's Application to amend the Patent in suit and are therefore admissible, including MWE 46 to MWE 50 that form part of this Rejoinder.
- 6.11 According to Rule 32.3 second sentence RoP, '(t)he Rejoinder shall be limited to the matters raised in the Reply'. Claimant requests under Rules 58, 36, 9.1 RoP admission of its submission also insofar as the submission is not limited to 'the matters raised in the Reply.' This request is to be denied, including not allowing MWE 45 ("Second Hajaligol Declaration") into the proceedings. There is no good reason why an exception should be made to the general rule in Rule 32.3 second sentence RoP. Claimant had the opportunity to present its case. In the interest of efficient proceedings, no further arguments can be introduced at this stage of the proceedings. Their admission would not be in line with the UPC's front-loaded approach. P. 1 to 14 of Claimant's submission of 22 April 2024 are therefore inadmissible.

Submission of 31 May 2024

- 6.12 Defendant's submission of 31 May 2024 is inadmissible, as there is no legal basis for it in the RoP. The submission stands in contrast the front-loaded approach of the UPC system. There are no good reasons why, as an exception, the submission should be admitted in this case.

Submission of 13 November 2024 and Auxiliary Requests IIA, VIIA, VIIIA, IXA and XIIA

- 6.13 Defendant's submission of additional Auxiliary Requests IIA, VIIA, VIIIA, IXA and XIIA submitted with the subsequent Application to amend the patent in suit of 13 November 2024 is inadmissible. As will be shown below, the arguments on which the current decision is based have been considered by the parties in their earlier submissions. As regards the Amendment A2 and A4, Claimant has raised the clarity objection on which this decision is based. Claimant has also raised the argument regarding the attachment and/or the enclosure of the mouthpiece to a second end. Defendant has had the

opportunity to react to this argument in the course of the written proceedings, i.e. in the Statement of Defence or in the Rejoinder at the latest.

7 Technical introduction

- 7.1 EP921 pertains to vaporization device systems. According to [0002] EP921, it pertains to improvements in electronic inhalable aerosol devices, or electronic vaping devices, particularly to electronic aerosol devices, which utilize a vaporizable material that is vaporized to create an aerosol vapor capable of delivering an active ingredient to a user.
- 7.2 EP921 describes EP 2 113 178 A1 to disclose an electrically heated smoking system comprising a shell and a replaceable mouthpiece. The shell comprises an electric power supply and electric circuitry. The mouthpiece comprises a liquid storage portion and a capillary wick. The mouthpiece also comprises a heating element for heating the second end of the capillary wick, an air outlet, and an aerosol forming chamber between the second end of the capillary wick and the air outlet.
- 7.3 EP921 further describes WO 2013/083635 A1 to disclose an aerosol generating device comprising a housing having a first air inlet and an air outlet, the housing defining an air flow channel between the first air inlet and the air outlet; and a heater configured to heat an aerosol-forming substrate positioned within or adjacent to the air flow channel; wherein the housing further comprises a second air inlet, the second air inlet positioned between the heater and the air outlet, the second air inlet configured to allow air into the air flow channel and wherein the second air inlet is larger than the first air inlet.

8 The claimed subject matter

- 8.1 The Patent, in its granted version, includes 14 claims.
- 8.2 Claim 1 of the Patent can be divided into the following features:

- 1.1 A device (10) for generating an inhalable aerosol comprising:*
- 1.2 a device body (20) comprising a cartridge receptacle (21); and*
- 1.3 a cartridge (30, 30a) comprising:*
 - 1.3.1 a heater (36, 105, 205, 305) comprising at least one condensation chamber,*
 - 1.3.2 a fluid storage compartment (32), and*
 - 1.3.3 a mouthpiece (31), wherein*

- 1.4 *the heater is attached to a first end of the fluid storage compartment (32),*
- 1.5 *the mouthpiece is attached to a second end of the fluid storage compartment (32), and*
- 1.6 *the device comprises an air inlet passage (51) formed when the cartridge is inserted into the cartridge receptacle (21),*

characterised in that either:

- 1.6.1 *- a channel integral to an exterior surface of the cartridge forms a first side of the air inlet passage and an internal surface of the cartridge receptacle forms a second side of the air inlet passage, or*
- 1.6.2 *- a channel integral to the internal surface of the cartridge receptacle forms the first side of the air inlet passage and the exterior surface of the cartridge forms the second side of the air inlet passage.*

8.3 Claim 11 of the Patent can be divided into the following features:

- 11.1 *A cartridge (30, 30a) configured to be inserted into a cartridge receptacle (21) of a device body, the cartridge comprising:*
- 11.2 *a heater (36, 105, 205, 305) comprising at least one condensation chamber,*
- 11.3 *a fluid storage compartment (32), and*
- 11.4 *a mouthpiece (31),*
- 11.5 *wherein the heater is attached to a first end of the fluid storage compartment (32),*
- 11.6 *the mouthpiece is attached to a second end of the fluid storage compartment (32),*
- 11.7 *and characterised in that the cartridge is configured to form an air inlet passage (51) when the cartridge is inserted into the cartridge receptacle (21),*
- 11.8 *wherein:*
 - a channel integral to an exterior surface of the cartridge is configured to form a first side of the air inlet passage and an*

internal surface of the cartridge receptacle is configured to form a second side of the air inlet passage.

- 8.4 Several features of claims 1 and 11 of the Patent require interpretation.

Legal framework

- 8.5 The Court of Appeal of the UPC has laid down the following legal framework for the interpretation of patent claims (Order dated 26 February 2024 in UPC_CoA_335/2023, *NanoString/10x Genomics*, p.26-27 of the original German language version, also see CoA UPC 13 May 2024, *VusionGroup/Hanshow*).
- 8.6 In accordance with Art. 69 EPC and the Protocol on its interpretation, a patent claim is not only the starting point, but the decisive basis for determining the scope of protection of a European patent. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.
- 8.7 The patent claim is to be interpreted from the point of view of a person skilled in the art. When interpreting a patent claim, the person skilled in the art does not apply a philological understanding, but determines the technical meaning of the terms used with the aid of the description and the drawings. A feature in a patent claim is always to be interpreted in light of the claim as a whole (CoA UPC 13 May 2024, *VusionGroup/Hanshow*, point 29). From the function of the individual features in the context of the patent claim as a whole, it must be deduced which technical function these features actually have both individually and as a whole. The description and the drawings may show that the patent specification defines terms independently and, in this respect, may represent a patent's own lexicon. Even if terms used in the patent deviate from general usage, it may therefore be that ultimately the meaning of the terms resulting from the patent specification is authoritative.
- 8.8 In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

- 8.9 The relevant point in time for interpreting a patent claim for the assessment of validity is the filing (or priority) date of the application that led to the patent.
- 8.10 The patent claim must be interpreted from the point of view of a person skilled in the art. The person skilled in the art (skilled person) is a legal fiction which, in the interests of legal certainty, forms a standardized basis for the assessment of the legal concepts of "prior art", "novelty", "inventive step" and "enablement". The skilled person stands for the average expert who is typically active in the technical field of the invention, has had the usual prior training and has acquired average knowledge, skills and practical experience.

The skilled person (person skilled in the art)

- 8.11 The person skilled in the art is a mechanical engineer with either a Bachelor's degree or as Master's degree in mechanical engineering and several years of experience in the technical field of electronic inhalable aerosol devices or electronic vaping devices, who may be assisted by an electrical engineer for those issues that relate to the electrical circuitry implemented in electronic inhalable aerosol devices or electronic vaping devices that he himself cannot handle.
- 8.12 Electronic inhalable aerosol devices or electronic vaping devices are consumer products. General tasks in designing electronic inhalable aerosol devices or electronic vaping devices relate to the outer physical shape and mechanical properties of the device; the materials to be used for the device; the inner physical shape of the device, also as regards fluid dynamics and thermodynamics. These tasks typically fall into the competence of a mechanical engineer and not so much into the competence of an electrical engineer, a chemist or a physicist (as suggested by Claimant (SfR, mn 9)).
- 8.13 A further task in designing electronic inhalable aerosol devices or electronic vaping devices relates to the electrical circuitry implemented in these devices. This additional design task can either be performed by a mechanical engineer with some years of experience in the technical field of vaporizers or by way of forming a team between the mechanical engineer and an electrical engineer.
- 8.14 Claimant states that, alternatively to a mechanical engineer, the skilled person could possess a Bachelor's or Master's degree in chemistry or physics or a related field or someone from a related field (mn 9 SfR). This is not convincing, as it would render the selection of the skilled person too

unspecific. Claimant does not provide any substantive reasons for suggesting these alternatives and hence does not provide any convincing arguments as to why Claimant's suggestion should prevail. Likewise, the statement by Mr. Hajaligol in mn 19 of MWE 20 also provides no further reasoning as to why Mr. Hajaligol is of the opinion that the person skilled in the art ought to be defined differently, hence – apart from a singular opinion - not providing any convincing arguments as to why Claimant's suggestion should prevail.

Claim interpretation from the point of view of the skilled person

Feature 1.4: *“the heater is attached to a first end of the fluid storage compartment”*

- 8.15 Feature 1.4 describes the heater to be attached to a first end of *the fluid storage compartment (abbreviated as “FSC” in the following)*. In doing so, feature 1.4 (1) defines the manufacturing step of attachment to be the one to be used to provide the FSC with the heater and (2) defines the location of at least the majority of the parts that make up the heater to be at a first end of the FSC.
- 8.16 To the skilled person, the term “attached” indicates an attachment of one object (the heater) to another, already existing object. In contrast to other manufacturing methods, for example where an object is created as part of an object by way of machining or where an object is cast, “attached” means the attachment of one existing object to another existing object to the skilled person.
- 8.17 This view is supported by the description of the Patent. For ease of reference, Fig. 7A, 7B and 9 are included below.
- 8.18 Fig. 7A is an isometric view of an assembled cartridge. Fig. 7B is an illustrative exploded isometric view of a cartridge assembly.



FIG. 7A

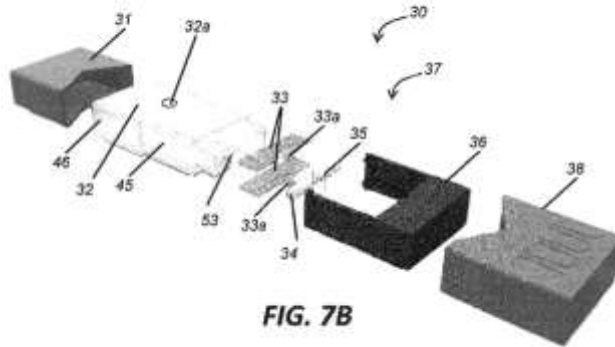


FIG. 7B

8.19 FIG. 9 provides an example of a method of assembling such a device. FIG. 9 is a sequence of the assembly method for the cartridge.

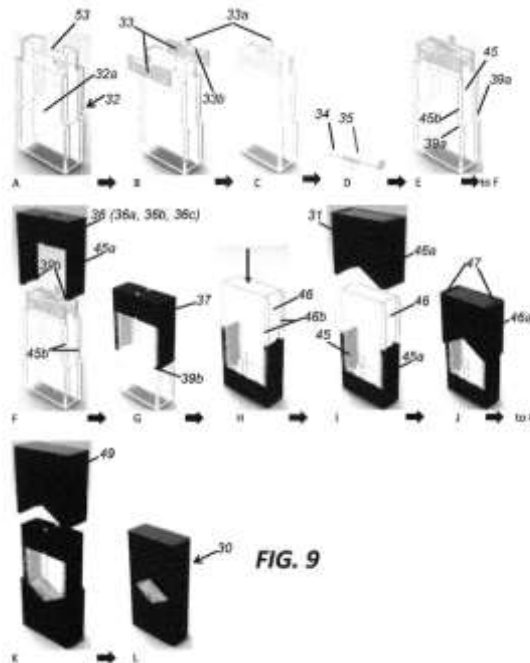


FIG. 9

8.20 From [0139], the skilled person learns that it is intended that the cartridge may be configured for ease of manufacture and assembly. From this, the skilled person understands that the intention of the reference in feature 1.4 to the heater being attached to a first end of the FSC (and the intention of

feature 1.5. *requiring a mouthpiece attached to a second end of the FSC*) is to be seen as means to achieve an ease of manufacture and assembly of the cartridge in contrast of other, more difficult manufacturing ways of providing a cartridge with a heater and a mouthpiece.

- 8.21 Claim 1 leaves it open if the heater is a unitary element that is attached to the end of the FSC in one unitary piece or if the heater is made up of several elements that are individually affixed to other parts of the FSC. The embodiment shown in Fig. 7B and assembled according to Fig. 9 is a heater made up of several parts and shows the individual parts of the heater to be affixed to pieces of the FSC in successive steps. From this the skilled person learns that the attachment of the heater to the elements of the FSC must not necessarily be done in one step. But the embodiment shown in Fig. 7B and assembled according to Fig. 9 shows that even if the heater is attached to elements of the FSC, each element of the heater is attached to other elements (in contrast to an element that forms part of the heater being formed by other ways on the FSC).
- 8.22 As regards the means of attachment, [0154] suggests the one or more free ends of the heater to be soldered in place (which is a means of permanent affixation), rested in a groove or snapped into a fitted location.
- 8.23 When taken literally, the term “attached to a first end of the fluid storage compartment” could be understood to define the “a first end of the fluid storage compartment” to be an existing (part of an) object to which the heater is affixed. Such an understanding of the term “attached to a first end of the FSC” is, however, in contradiction to the description. [0151] describes a small male snap feature 39b located at the end of the channel cover (of the heater) to be configured to fall into a female snap feature 39a, located mid-body on the side of the tank and creating a snap-fit assembly. To the skilled person this means that the actual point of attachment of the heater to the FSC takes place mid-body on the side of the tank; the term “tank” at least in [0151] being understood by the skilled person to be synonymous to the term “fluid storage compartment”. Using the description and the drawings as explanatory aids for the interpretation of the patent claim the skilled person understands that the term “to a first end of the FSC” in the term “attached to a first end of the FSC” defines the location where the heater is after having being attached rather than being a reference to an existing (part of an) object to which the heater is affixed.
- 8.24 From the embodiment described in [0151], the skilled person understands that feature 1.4 does not necessitate the complete heater to be located at

the first end of the FSC. While in the embodiment described in [0151] the majority of the parts that make up the heater is located at a first end of the FSC, the channel covers protrude from the end of the first cartridge and hence are not completely located at the first end of the cartridge. From this, the skilled person understands that feature 1.4 relates to at least the majority of the parts that make up the heater to be at a first end of the FSC.

Feature 1.5: *“the mouthpiece is attached to a second end of the fluid storage compartment”*

- 8.25 Feature 1.5 describes the mouthpiece to be attached to a second end of FSC. In doing so, feature 1.5 (1) defines the manufacturing step of attachment to be the one to be used to provide the FSC with the mouthpiece and (2) defines the location of the free end of the mouthpiece that is intended to be inserted into the user’s mouth at a second end of the FSC.
- 8.26 As indicated above, the term “attached” to the skilled person indicates an attachment of one object (the mouthpiece) to another, already existing object. As indicated above, this method is seen by the skilled person as the one to achieve an ease of manufacture and assembly of the cartridge in contrast of other, more difficult manufacturing ways of providing a cartridge with a heater and a mouthpiece.
- 8.27 As indicated above, when taken literally, the term “attached to a second end of the fluid storage compartment” could be understood to define the “a second end of the fluid storage compartment” to be an existing (part of an) object to which the mouthpiece is affixed. Such an understanding of the term “attached to a second end of the fluid storage compartment” is, however, in contradiction to the description.
- 8.28 [0175] describes a snap-fit coupling 39c, 39d of the mouthpiece to be similar to the snap-fit coupling 39a, 39b. Fig. 9I and 9J show that the mouthpiece 31 is to be slid onto the fluid storage compartment 32a in a manner similar to the heater 36 being slid onto the fluid storage compartment 32 in Fig. 9F, 9G. Further, Fig. 9I and 9J show the mouthpiece to have lateral extensions (aerosol outlet channel covers 46a) similar to the lateral extensions (primary condensation channel covers 45a). Starting from this, the skilled person understands the reference in [0175] to teach that the snap-fit coupling 39c, 39d is to be similar to the snap-fit coupling 39a, 39b. Hence, the snap-fit coupling 39c, 39d consist of a small male snap feature 39d located at the end of the aerosol outlet channel covers 46a which can be configured to fall into

a female snap feature 39c, located mid-body on the side of the tank and creating a snap-fit assembly.

- 8.29 To the skilled person, this means that the actual point of attachment of the mouthpiece to the FSC in this embodiment takes place mid-body on the side of the tank. On the other hand, the skilled person realizes especially from Fig. 7A, 9I and 9J that the mouthpiece is affixed in a particular orientation, namely in such a way that the free end of the mouthpiece that is intended to be inserted into the user's mouth is located at a second end of the FSC.
- 8.30 Similar to feature 1.4, using the description and the drawings as explanatory aids for the interpretation of the patent claim, the skilled person understands that the term "to a second end of the FSC" in the term "attached to a second end of the FSC" defines the location of the free end of the mouthpiece that is intended to be inserted into the user's mouth to be at a second end of the FSC.
- 8.31 Taking the description and the drawings as explanatory aids for the interpretation of the patent claim, in the features 1.4 and 1.5 both references to "end of the fluid storage compartment" (first end of the fluid storage compartment; second end of the fluid storage compartment) need to be interpreted and are interpreted in a similar way, in order to be in line with the description. The need to apply this interpretation to two individual features in the same way reinforces the interpretation for the respective one of the two features.

9 Validity

- 9.1 The Patent is not valid. It extends beyond the content of the European Patent Application as filed (MWE 3) and beyond the content of the parent application (MWE 4). Especially, MWE 3 and MWE 4 do not specify that the heater is attached to a first end of the fluid storage compartment (features 1.4 and 11.5) in the way as this term needs to be understood by way of claim interpretation and do not specify that the mouthpiece is attached to a second end of the fluid storage compartment (features 1.5 and 11.6) in the way as this term needs to be understood by way of claim interpretation.

Legal framework

- 9.2 An amendment is regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of

addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. Any amendment can only be made within the limits of what a skilled person would directly and unambiguously derive, using common general knowledge, and seen objectively and relative to the date of filing (or the priority date, where appropriate), from the whole of the documents as filed (LD The Hague, UPC_CFI_131/2024 ACT_14945/2024; order of 19 June 2024; page 12, mn 3.4).

- 9.3 Given that the Patent is a divisional application, the Patent is to be revoked if any one of the following conditions applies:
1. the Patent extends beyond the content of the European application as filed 18000692.6 (MWE 3);
 2. the Patent extends beyond the content of the earlier application European application 14873186.2 (the parent application; WO 2015/100361 A1; MWE 4), the European Patent in suit being granted on a divisional application to this earlier application.

Granted claims 1 and 11 are not disclosed verbatim in the applications

- 9.4 The precise wording used for granted claim 1 (“device claim”) and used for granted claim 11 (“cartridge claim”) in its combination and flow of words (claim 1 “verbatim”, claim 11 “verbatim”) can as such not be found in WO 2015/100361 A1 (MWE 4), i.e., the parent application 14873186.2, nor in the application 18000692.6 as filed (MWE 3).

9.5 As pointed out by the Claimant, claim 1 differs from claim 1 of the application as filed (MWE 3) in the following manner:

~~A device (10, 100, 20, 200, 2302, 300, 400) for generating an inhalable aerosol from a liquid vaporizable material, the device comprising:~~

~~a device body (20, 101, 201, 301, 401) comprising a cartridge receptacle (21);~~

~~and~~

~~a separable-cartridge (30, 30a) comprising~~

~~a heater (36, 105, 205, 305) comprising at least one condensation chamber,~~

~~a fluid storage compartment (32), and~~

~~a mouthpiece (31, 102, 202, 222, 302), wherein~~

~~the heater is attached to a first end of the fluid storage compartment (32),~~

~~the mouthpiece is attached to a second end of the fluid storage compartment~~

~~(32), and~~

~~characterized in that the device comprises an air inlet passage (51121, 221,~~

~~321, 421) formed by the device body (20, 101, 201, 301, 401) and the separable~~

~~cartridge when the cartridge is inserted into the cartridge receptacle (21), char-~~

~~acterised in that either:~~

~~- a channel integral to an exterior surface of the cartridge forms a first side of the air inlet passage and an internal surface of the cartridge receptacle forms a second side of the air inlet passage, or~~

~~- a channel integral to the internal surface of the cartridge receptacle forms the first side of the air inlet passage and the exterior surface of the cartridge forms the second side of the air inlet passage.~~

9.6 Claimant points out that claims 1 and 11 specify that “the heater is attached to a first end of the fluid storage compartment” while the description as originally filed and the parent application as originally filed describe the heater as being attached to, or enclosing, a “first end of the cartridge”. According to Claimant, the attachment of the heater to a first end of the fluid storage compartment is neither disclosed by, nor directly and unambiguously derivable from, statements that the heater is attached to the first end of the cartridge or statements that the heater encloses a first end of the fluid storage compartment.

9.7 Claimant argues that claims 1 and 11 specify that “the mouthpiece is attached to a second end of the fluid storage compartment” while the description as originally filed and the parent application as originally filed describe the

mouthpiece as being attached to, or enclosing, a “second end of the cartridge”. According to Claimant, the attachment of the mouthpiece to a second end of the fluid storage compartment is not disclosed by, or derivable directly and unambiguously from, statements that the mouthpiece is attached to the second end of the cartridge or statements that the mouthpiece encloses a second end of the fluid storage compartment.

- 9.8 Claimant has shown that there are differences between the originally filed claim 1 that are to be considered for the patent to contain subject matter that extends beyond the content of the application as filed. As a consequence, it is Defendant’s burden of proof to show, that all the changes made to what he considers as a generic disclosure basis for granted claim 1 (the changes made to claim 149 or claim 158) do not result in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art

Starting from starting point used by Defendant within the parent application (MWE 4)

- 9.9 In mn 51 and 52 of the DtR, Defendant refers to the original claims 149 and 158 of WO 2015/100361 A1 (MWE 4) as a generic disclosure basis for feature 1.4 and 1.5, as well as feature 11.5 and 11.6.
- 9.10 Claim 149 of MWE 4 reads:

149. A cartridge for a device for generating an inhalable aerosol comprising:
a fluid storage compartment;
a heater affixed to a first end; and
a mouthpiece affixed to a second end;
wherein the heater comprises a first condensation chamber and the mouthpiece comprises a second condensation chamber.

- 9.11 Granted claim 1 differs as far as relevant here, from the disclosure of claim 149 in that granted claim 1 specifies that
- the first end mentioned in claim 1 is the first end of the fluid storage compartment, while claim 149 of MWE 4 does not specify to which object the first end belongs;

- the second end mentioned in claim 1 is the second end of the fluid storage compartment, while claim 149 of MWE 4 does not specify to which object the second end belongs.

9.12 Granted claim 11 differs as far as relevant here, from the disclosure of claim 149 in that granted claim 11 specifies that

- the first end mentioned in claim 1 is the first end of the fluid storage compartment, while claim 149 of MWE 4 does not specify to which object the first end belongs;
- the second end mentioned in claim 1 is the second end of the fluid storage compartment, while claim 149 of MWE 4 does not specify to which object the second end belongs;

9.13 Claim 158 of MWE 4 reads

158. A method of fabricating a cartridge for a device for generating an inhalable aerosol comprising:

- providing a fluid storage compartment;
- affixing a heater to a first end with a snap-fit coupling; and
- affixing a mouthpiece to a second end with a snap-fit coupling.

9.14 Granted claim 1 differs as far as relevant here, from the disclosure of claim 158 in that granted claim 1 specifies

- the first end mentioned in claim 1 is the first end of the fluid storage compartment, while claim 158 of MWE 4 does not literally specify to which object the first end belongs;
- the second end mentioned in claim 1 is the second end of the fluid storage compartment, while claim 158 of MWE 4 does not literally specify to which object the second end belongs.

9.15 Granted claim 11 differs as far as relevant here, from the disclosure of claim 158 in that granted claim 11 specifies

- the first end mentioned in claim 11 is the first end of the fluid storage compartment, while claim 158 of MWE 4 does not literally specify to which object the first end belongs;
- the second end mentioned in claim 11 is the second end of the fluid storage compartment, while claim 158 of MWE 4 does not literally specify to which object the second end belongs

- 9.16 The question arises whether Defendant has shown that MWE 4 – while it does not disclose literally in claim 149 and 158 for the heater to be attached to the first end of the fluid storage compartment and the mouthpiece to be attached to the second end of the fluid storage compartment – in another way discloses the “first end” mentioned in claim 149 and 158 to be the first end of the fluid storage compartment and the “second end” mentioned in claim 149 and 158 to be the second end of the fluid storage compartment.
- 9.17 The wording of both claim 149 and 158 of MWE 4 leave it undefined to the (respective end of) which component the heater and the mouthpiece are affixed to. Nothing can be gained from the mere structure of claim 149 and 158, which places the term “fluid storage compartment” before the terms “first end” and “second end”. This sequence does not define that the first end must be the first end of the fluid storage compartment and the second end must be the second end of the fluid storage compartment. Like the “fluid storage compartment”, also the term “cartridge” is introduced into the respective claim prior to the features concerning the affixation of the heater and the mouthpiece to certain ends. Hence, from a structural perspective, both terms have been introduced into the claim prior to the mention of “a first end” or “a second end”, leaving it ambiguous if the terms “first end” or “second end” introduced further down in the claim refer back to either of the terms “cartridge” or “fluid storage compartment” (at all), and if so, to which one of the two terms. For similar reasons, Claimant’s argument that it *must* be the first/second end of the cartridge that is being referenced in claim 149 and claim 158 does also not convince. It is true – as Claimant points out in the statement for revocation (mn. 30) - that at several places of the parent application MWE 4 the heater is stated to be attached to or to enclose the first end of the cartridge. Similarly, in the statement for revocation (mn. 38), Claimant quotes several examples of the parent application in which the mouthpiece may be attached to or may enclose the second end of the cartridge. However, the mere fact that the claims 149 and 158 mention the cartridge does not necessitate the terms “first end”/ “second end” to refer to the cartridge; as indicated above, claims 149 and 158 also mention the term “fluid storage compartment”. Claims 149 and 158 simply leave it open, if the terms “first end” and “second end” actually are intended to describe ends of an object that has been introduced into the claim language at an earlier stage and even if they were considered to describe an end of an object that has

been introduced into the claim language at an earlier stage, which of the two objects it is.

- 9.18 The same ambiguity is present in [0042] and [0046] and [0048] of MWE 4, to which Defendant also refers. Like the “fluid storage compartment”, the term “cartridge” is also introduced into the respective paragraph prior to the features concerning the affixation of the heater and the mouthpiece to certain ends. [0042] and [0046] and [0048] of MWE 4 are hence ambiguous as to which object the ends belong, to which the heater and the mouthpiece are affixed; it could be the cartridge or it could be the fluid storage compartment or it could even be something else. [0042] and [0046] and [0048] of MWE 4 leave this open.
- 9.19 Defendant further emphasizes that claim 158 pertains to a method claim and – in Defendant’s view - describes that MWE 4 discloses that the mouthpiece and the heater are attached to the fluid storage compartment. According to Defendant, claim 158 describes how the cartridge is being manufactured by describing the steps by which the heater and a mouthpiece are affixed to a first/second end.
- 9.20 The teaching contained in claim 158, however, remains ambiguous, even if it is taken into account that claim 158 is a method claim. Claim 158 contains a list of steps which have to be performed in order to manufacture the cartridge; therefore, the reference to “first end”/“second end” in claim 158 could, for example, also mean the manufacture of the first/second end of the cartridge; this construction of claim 158 is further supported by the description which says that the heater is attached to first end of cartridge and the mouthpiece is attached second end of the cartridge. Hence, the circumstance that claim 158 is worded as a method-claim does not resolve the ambiguity highlighted above.
- 9.21 Defendant also refers to [00179] and Fig. 9.
- 9.22 In the context of Fig. 9I and 9J Defendant states (mn 59 DfR) that these figures show a cartridge to comprise a fluid storage compartment (transparent component) to which a mouthpiece (component 31) and a heater (black component on the bottom side) are *attached*. Defendant does not specify here whether Defendant believes Fig. 9I and 9J to show the particularities of the attachment of the heater and the mouthpiece and in particular whether Defendant believes Fig. 9I and 9J to show the heater to be attached to the first end of the fluid storage compartment and to show the mouthpiece to be attached to the second end of the fluid storage compartment. Fig. 9I and Fig.

9J show an embodiment, in which the mouthpiece (component 31) encloses an end of the fluid storage compartment and in which the heater encloses an end of the fluid storage compartment. Further particularities of the actual attachment cannot be derived from Fig 9I and 9J alone, but only in conjunction with the paragraphs of the description that explain what is to be shown by Fig. 9I and 9J, in particular in conjunction with [00179].

- 9.23 In the context of [00179] Defendant also initially states this paragraph to specify in relation to Fig. 9 a fluid storage compartment having the heater and the mouthpiece attached thereto (mn 60 DtR). Additionally, Defendant claims, however, that [00179] with reference to Fig. 9 describes step-by-step how the heater and the mouthpiece are attached to the first and second ends of the fluid storage compartment (mn 61 DtR) and that Figs. 9B to 9L show, how different components like the heater and the mouthpiece are attached to the first end and the second end of the fluid storage compartment (mn 63 DtR). The reasons provided by Defendant do, however, not support these statements.
- 9.24 Defendant's reference to the statement that "heater 35 may be placed on the fluid storage compartment" (mn 64 DfR) does not support the above statement, because a placement of an object on a different object says nothing about an attachment of the one object to the object on which it is placed. Fig. 9E (to which the cited sentence in [00179] refers by reference to "step E") shows elements of the heater (for example the heater coil for which the reference sign 35 is used together with a wick 34) placed on the fluid storage compartment, without giving any guidance for the arrangement of the complete heater, let alone any attachment that would go beyond a mere placement.
- 9.25 Defendant's reference to the statement that "the heater enclosure 36 is in place on the fluid storage compartment" and to Fig. 9F and 9G (mn 65, 66, 67 DfR) does not support the above statement, because for an object to be in place on a different object says nothing about an attachment of the one object to the object on which it is in place. Fig. 9F and 9G (to which the cited sentence in [00179] refers by reference to "step G") shows a heater enclosure 36 to enclose an end of the fluid storage compartment, with elements reaching along the side of the fluid storage compartment, but not providing any disclosure for an attachment to a first end of the fluid storage compartment.
- 9.26 Defendant's reference to the statement that "the heater enclosure 36 may be fitted on the fluid storage compartment" and to the statement that "the

mouthpiece 31 can be fitted on the fluid storage compartment” (mn 68 DfR) does not support the above statement, because fitting one object on a different object relates to the geometric adaptation of the shape of the one element to the geometric shape of a different element it is being fitted on, but apart from indicating a geometric adaptation is silent and especially is silent about the presence of and particular realization of an attachment. Furthermore, the cited sentences do not relate to a fitting to an end of the fluid storage compartment and hence already for this reason provide not guidance on an attachment to an end of the fluid storage compartment.

- 9.27 Defendant’s reference to Fig. 9I in the context of the mouthpiece (mn 70) does not support the above statement, because Fig. 9I shows a cap-like mouthpiece 31 above an end of the fluid storage compartment; Fig. 9I by itself is not providing any information on how the mouthpiece is attached to the fluid storage compartment. Defendant’s reference to Fig. 9J in the context of the mouthpiece (mn 70) does not support the above statement, because Fig. 9J shows the cap-like mouthpiece 31 being placed over an end of the fluid storage compartment in a manner that it encloses about half of the fluid storage compartment; Fig. 9J by itself is not providing any information on how the mouthpiece is attached to the fluid storage compartment. Similarly, Defendant’s reference to the statement “Step J shows the mouthpiece 31 in place on the fluid storage compartment” does not support the above statement, because – as stated above - for an object to be in place on a different object says nothing about the particularities of an attachment of the one object to the different object, on which it is placed.
- 9.28 Fig. 9, however, shows a particular embodiment, wherein the heater enclosure 36 encloses the first end of the fluid storage compartment and wherein the mouthpiece encloses the second end of the fluid storage compartment. Any disclosure of [00179] takes place in conjunction with this particular embodiment.
- 9.29 The claim feature 1.4 and 11.5 concerning the attachment of the heater to a first end of the fluid storage compartment is neither disclosed by, nor directly and unambiguously derivable from [00179], which, by way of reference to Fig. 9, relates to a heater that encloses a first end of the fluid storage compartment.
- 9.30 Similarly, claim feature 1.5 and 11.6 concerning the attachment of the mouthpiece to a second end of the fluid storage compartment is not disclosed by, or derivable directly and unambiguously from [00179], which by

way of reference to Fig. 9 relates to a mouthpiece that encloses a second end of the fluid storage compartment

- 9.31 For a cartridge that has a heater being attached to the first end of the fluid storage compartment and a mouthpiece being attached to the second end of the fluid storage compartment, the embodiment of Fig. 7B, 9A-L described in [00179] of MWE 4 (and the same is true for the embodiment of Fig. 7B, 9A-L described in [00179] and of MWE 3 that are the identical Fig. and text passages in the application as filed) only presents to the skilled person the information to have the heater enclose the first end of the fluid storage compartment and mouthpiece enclose the second end of the fluid storage compartment.
- 9.32 The same considerations apply with regard to the cartridge claim feature 11.5 and 11.6, as the wording of these features as well as the relevant disclosure is identical to features 1.4 and 1.5.
- 9.33 As a consequence, any claim that refers to the heater being attached to a first end of the fluid storage department and the mouthpiece being attached to a second end of the fluid storage compartment while not defining, that the heater encloses the first end of the fluid storage compartment and the mouthpiece encloses the second end of the fluid storage compartment results in the skilled person being presented with information, which is not directly and unambiguously derivable from that application as filed (MWE 3) and which is not directly and unambiguously derivable from the parent application MWE 4.
- 9.34 Claims 1 and 11 of the Patent hence extend beyond the content of the European application as filed application 18000692.6 (MWE 3) and beyond the parent application; WO 2015/100361 A1 (MWE 4).
- 9.35 For the reasons given above, the Patent cannot be maintained as granted in its entirety; as regards claim 1 and 11 it is to be revoked.

10 Defendant's Auxiliary Requests

Request (1)/ Request (2) a.

- 10.1 The Patent cannot be maintained as granted in its entirety. Defendant's request (1), according to which the revocation action is to be dismissed, is rejected. Similarly, request (2) a., according to which the patent be maintained as granted, is to be rejected.

Request (2) b.

- 10.2 With request (2) b., Defendant requests admission of the subsequent Application to amend the patent in suit (to include Auxiliary Requests IIA, VIIA, VIIIA, IXA and XIIA). The Court does not give permission for the subsequent Application to amend as lodged by the Defendant on 13 November 2024 comprising new auxiliary requests.
- 10.3 The reason for filing the subsequent Application to amend that was provided by the Defendant was the decision issued on 5 November 2024 (in the following “EP 115 decision”) by the same Panel of the UPC in the parallel revocation action regarding the Defendant’s patent EP 3 498 115 (UPC_CFI_309/2023 - ACT_571669/2023). The explanation provided by Defendant as to why it was not possible to set out their full case (by filing the particular auxiliary request of the submission of 13. November 2024) was that it was a reaction to the EP 115 decision issued on 5 November 2024 by the same Panel. Defendant states that the conclusion that the auxiliary request “the mouthpiece (31) encloses the second end of the cartridge (30, 30a) and the second end of the fluid storage compartment (32)” lacks clarity was surprising, because such clarity objections were not raised by Claimant in the EP 115 revocation proceedings. Further, the circumstances of the case must be taken into account. There was no case law from the UPC on clarity at the time of filing the Application to amend the patent.
- 10.4 Under the front-loaded system of UPC proceedings, parties are under an obligation to set out their full case as early as possible (Preamble RoP 7, last sentence). The subsequent Application to amend was filed late in the proceedings, after closure of the written proceedings and after the interim conference, less than one week before the oral hearing. The reasoning adopted in the EP 115 decision does not justify allowing the new auxiliary request into these proceedings at this stage of the proceedings. Although Defendant indeed acted swiftly in submitting the application within one week after the EP 115 decision becoming available, the substantive part of the EP 115 decision that triggered the filing of new auxiliary requests, i.e. the claim clarity argument, could not have come as a surprise to Defendant. In the current proceedings, the “clarity argument”, i.e. the argument that the term “the mouthpiece (31) encloses the second end of the cartridge (30, 30a) and the second end of the fluid storage compartment (32)” is unclear, has been raised by Claimant in the present proceedings in its Reply to Defence to Revocation and Defence to an Application to amend the Patent in mn 359, 390.

10.5 Furthermore, a possible “surprise” in the EP 115 proceedings, as regards the mouthpiece, does not justify any amendment to claims regarding the heater, yet in Auxiliary Requests IIA, VIIA, VIIIA, IXA and XIIA Defendant makes amendments both to the feature concerning the mouthpiece and the feature concerning the heater.

Request (2) c.

10.6 With request 2c, Defendant requests to amend the patent based on the Auxiliary Requests I to XII as submitted on 30 October 2024.

10.7 The Court uses the discretion given within Rule 9.2 RoP and – contrary to Claimant’s request - will not disregard the auxiliary requests 1 to 12 filed by Defendant on 30 October 2024. The order of 25 June 2024 gave Defendant the option (“may identify”) to narrow down the set of auxiliary requests already on file. The Court considers Defendant’s motion to narrow down the auxiliary to the auxiliary requests I to XII as expedient for an efficient procedure and hence beneficial to Claimant, too. Without the motion to file the auxiliary requests I to XII, the originally filed auxiliary requests 1 to 57 would have remained on file to be dealt with in a manner that would yet have to be decided.

10.8 None of the claims of auxiliary requests **I, III, IV, V, VI, X, XI** specify the heater to enclose the first end of the fluid storage compartment and the mouthpiece to enclose the second end of the fluid storage compartment. Hence none of the claims of these auxiliary requests introduce limitations that would lead to their subject matter being considered to not extend beyond the application as filed European application 18000692.6 (MWE 3), and parent application WO2015/100631 (MWE 4).

10.9 None of the requests **II, VII, VIII, IX, XII** explains how the mouthpiece and the heater can, at the same time, enclose the fluid storage compartment and be a part of this fluid storage compartment at the same time. Therefore, they have to be considered to be unclear.

Auxiliary request I

10.10 By adding the feature “wherein the heater is attached to a first end of the cartridge (30, 30a)”, the statement “the heater is attached to a first end of the fluid storage compartment (32)” is maintained. By adding the feature “wherein the mouthpiece is attached to a second end of the cartridge (30,

30a)", the statement "the mouthpiece is attached to a second end of the fluid storage compartment (32)" is maintained.

- 10.11 As indicated above, Defendant has not shown a basis for the general wording: "the heater is attached to a first end of the fluid storage compartment" and "the mouthpiece is attached to a second end of the fluid storage compartment". The lack of basis of these statements remains. Claim 1 and 11 of the auxiliary request do not introduce limitations that would lead to its subject matter being considered to not extend beyond the content of the application as filed, namely European Patent Application 18000692.6 and the parent application WO 2015/100361 A1.

Auxiliary request II, VII, VIII, IX, XII

- 10.12 Claim 1 of auxiliary request II, VII, VIII, IX, XII contains the limitation "the heater (31) encloses the first end of the cartridge (30, 30a) and the first end of the fluid storage compartment (32)". It also contains the limitation "the mouthpiece (31) encloses the second end of the cartridge (30, 30a) and the second end of the fluid storage compartment (32)".
- 10.13 This wording is unclear. It is unclear how the heater/mouthpiece can enclose the first/second end of the fluid storage compartment and at the same time enclose the first/ second end of the cartridge.
- 10.14 The same applies mutatis mutandis to claim 11 of auxiliary request II, VII, VIII, IX, XII.
- 10.15 Regarding the heater, Defendant states that the amendment A2 (that contains language "*wherein the heater (36, 105, 205, 305) encloses the first end of the cartridge (30, 30a) and the first end of the fluid storage compartment (32)*") clarifies that the heater encloses a first end of the cartridge and the first end of the fluid storage compartment. Providing such a statement does not fulfil the requirement to explain as to why the amendments satisfy the requirements of Article 84 EPC.
- 10.16 In mn 1042 DtR, Defendant states the amendment A4 (that contains the language "the mouthpiece (31) encloses the second end of the cartridge (30, 30a) and the second end of the fluid storage compartment (32)") to not introduce any unclarity and for the claim language to be clear. Providing such a statement does not fulfil the requirement to explain as to why the amendments satisfy the requirements of Article 84 EPC.
- 10.17 In mn 1039 DtR, Defendant refers to paragraphs [0023], [0041], [00183], [00187], [00241] of the original application documents as basis for the

amendment. [0023], [0041], [00183], [00187], [00241] of MWE 3 in essence are verbatim repetitions of the phrase “the mouthpiece encloses the second end of the cartridge and the second end of the fluid storage compartment”. However, a mere repetition of an unclear phrase does not make it clear. Defendant does not argue that the context, in which the phrase is placed in [0023], [0041], [00183], [00187], [00241] would render it clear – and indeed [0023], [0041], [00183], [00187], [00241] do not make the phrase any clearer.

- 10.18 Furthermore, Defendant leaves it unexplained, what indeed is meant by the double condition that the mouthpiece (1) encloses the second end of the cartridge and (2) encloses the second end of the fluid storage compartment. The Application to amend the patent according to auxiliary request II, VII, VIII, IX, XII hence needs to be rejected.

Auxiliary request III, IV, V, VI, X, XI

- 10.19 Claim 1 and 11 of auxiliary request III contain the additional limitation “wherein the cartridge (30, 30a) is detachable, wherein the cartridge receptacle (21) and the detachable cartridge form a separable coupling, and wherein the separable coupling comprises a magnetic assembly”.
- 10.20 By adding this feature, the statement “the heater is attached to a first end of the fluid storage compartment (32)” is maintained and the statement “the mouthpiece is attached to a second end of the fluid storage compartment (32)” is maintained. As indicated above, Defendant has not shown a basis for the general wording: “the heater is attached to a first end of the fluid storage compartment” and “the mouthpiece is attached to a second end of the fluid storage compartment”. The lack of basis of these statements remains. Claim 1 and 11 of the auxiliary request III do not introduce limitations that would lead to its subject matter being considered to not extend beyond the content of the application as filed, namely European Patent Application 18000692.6 and the parent application WO 2015/100361 A1. The same applies for the features introduced by auxiliary requests IV, V, VI, X, XI. Still after adding the features to claim 1 and claim 11 of auxiliary request IV, V, VI, X, XI as suggested by Defendant, the statement “the heater is attached to a first end of the fluid storage compartment (32)” is maintained and the statement “the mouthpiece is attached to a second end of the fluid storage compartment (32)” is maintained. As indicated above, Defendant has not shown a basis for the general wording: “the heater is attached to a first end of the fluid storage compartment” and “the mouthpiece is attached to a second end of the fluid storage compartment”. The lack of basis of these statements remains. Claim

1 and 11 of the auxiliary request IV, V, VI, X, XI do not introduce limitations that would lead to its subject matter being considered to not extend beyond the content of the application as filed, namely European Patent Application 18000692.6 and the parent application WO 2015/100361 A1.

Defendant's request (2) c. – as far as it refers to (2) b. of SoD

- 10.21 Defendant requests the review of the 65 auxiliary requests. This request is to be rejected as far as it is not concerned with the 12 auxiliary requests which have been considered under request (2) b. As far as the request goes beyond this limited list with which the court has already dealt, it is to be rejected as unreasonable in number. According to R 50.2 RoP in conjunction with R 30.1 (c), proposed amendments, if they are conditional like in the present case, must be reasonable in number in the circumstances of the case. In the particular case, the proposed twelve conditional amendments that form the twelve auxiliary requests of request are considered to be the upper limit of what can be considered reasonable. The conditional amendments that are further proposed by request (2) c. are considered not reasonable in number and hence not allowed.

Defendant's request (2) c. – as far as it refers to (2) c. of SoD

- 10.22 Defendant's request as far as it refers to (2) c. of SoD is to be rejected. With this request, Defendant requests a review of the subclaims. The grounds for revocation affect the Patent in its entirety. None of the further claims 2 to 10, which each build on claim 1, specify the heater to enclose the first end of the fluid storage compartment and the mouthpiece to enclose the second end of the fluid storage compartment.
- 10.23 The same holds true for claim 12 to 14, which each build on independent claim 11. None of them specify the heater to enclose the first end of the fluid storage compartment and the mouthpiece to enclose the second end of the fluid storage compartment.
- 10.24 Hence none of the further claims introduce limitations that would lead to their subject matter – in combination with claim 1 respectively in combination with claim 11, on which they build - being considered to not extend beyond the application as filed European application 18000692.6 (MWE 3), and parent application WO2015/100631 (MWE 4).

Defendant's request (2) c. – as far as it refers to (2) d. of SoD

- 10.25 Defendant's request (2) d. as set forth in the Statement of Defence needs to be rejected.
- 10.26 From the outset, Defendant's request (2) d. is unclear and already for this reason unallowable. Defendant did not file any particular claim-sets that would indicate to the Court, which combinations of claims Defendant would want the Court to examine under request (2) d. in which order.
- 10.27 The wording "one or more of its dependent claims as granted in combination with claim 1" leaves it undefined, which combination of claims Defendant would like the court to start with. Defendant's request (2) d. could – as an example - be understood to mean for the Court to start with granted claim 2 in combination with claim 1 of auxiliary request 1 as much as it could mean – as an example – granted claim 6 in combination with claim 1 of the auxiliary request 1. For an orderly procedure, the requests of a party need to be precise and without ambiguity. This criterion is not met by request (2) d.
- 10.28 In addition, according to R 50.2 RoP with R 30.1 (c) proposed amendments, if they are conditional like in the present case, must be reasonable in number in the circumstances of the case. In the particular case, the proposed twelve conditional amendments that form the twelve auxiliary requests of request (2) b. are considered to be the upper limit of what can be considered reasonable. The conditional amendments that are further proposed by request (2) d. are considered not reasonable in number and hence not allowed.
- 10.29 In addition, the auxiliary request (2) d. is not supported by any arguments from Defendant. Defendant does not argue that any of the proposed amendments that are contained in the auxiliary request (2) d. would provide particular reason to uphold the patent in the thus amended form.

11 Costs

- 11.1 In accordance with Article 69 UPCA and Rule 118.5 RoP, Defendant, as the unsuccessful party, the Patent being revoked entirely, has to bear the legal costs of Claimant.

DECISION

Having heard the parties on all relevant aspects of the case, the Central Division:

1. Revokes European patent n° EP 3 430 921 with effect for the territories of Belgium, France, Germany, Italy, Luxembourg, Netherlands, Portugal and Sweden.
2. Admits documents MWE 20 to MWE 44 and MWE 46 to MWE 50 into the proceedings.
3. Does not admit pages 1 -14 of Claimant’s submission of 22 April 2024, including MWE 45.
4. Admits p. 15-80 of Claimant’s submission of 22 April 2024.
5. Does not admit Defendant’s submission of 31 May 2024.
6. Does not admit Defendant’s Auxiliary Requests IIA, VIIA, VIIIA, IXA and XIIA of the submission of 13. November 2024.
7. Orders that the Registry shall send a copy of this decision to the European Patent Office and to the national patent office of any Contracting Member States concerned, after the deadline for appeal has passed.
8. Orders Defendant to bear the costs of the proceedings.

NAMES AND SIGNATURES	
Judges	For the Deputy-Registrar
Presiding judge:	
Legally qualified judge and judge-rapporteur:	
Technically qualified judge:	

Information about appeal

An appeal against the present Decision may be lodged at the Court of Appeal, by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of its notification (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

Information about enforcement

Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP.

An authentic copy of the enforceable decision will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.

ORDER DETAILS

Decision no. ORD_598564/2023 in ACTION NUMBER: ACT_571808/2023

UPC number: UPC_CFI_316/2023

Action type: Revocation Action